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10/566,871	02/02/2006	Hiroshi Mukaihara	45010005211	2222

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EXAMINER
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/566,871	MUKAIHARA ET AL.
	Examiner	Art Unit	
	MARK A. GIARDINO JR	2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 November 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>9-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>9-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail. Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

The Examiner acknowledges the applicant's submission of the amendment dated 11/7/2008. At this point, claims 9, 11, and 13 have been amended and no claims have been added or cancelled. Thus, claims 9-15 are pending in the instant application.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 4 dependent claims, all of which are ready for examination by the examiner.

REJECTIONS NOT BASED ON PRIOR ART

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation in claims 9, 11, and 13 "independently of the user's operation to change the selected data" is not adequately described in the drawings or specification. Paragraphs 0038, 0039, and 0043 state that the file is selected by the user, but not that this selection is independent of the user's operation to change selected data.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 11, and 15 recites the limitation "independently of the user's operation to change the selected data". There is insufficient antecedent basis for this limitation in the claim.

35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the limitation in claims 9, 11, and 13 "independently of the user's operation to change the selected data". Paragraphs 0038, 0039, and 0043 state that the file is selected by the user, but not that this selection is independent of the user's operation to change selected data.

Applicant is required to cancel the new matter in the reply to this Office Action.

REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle (US 2001/0041021) in view of Bateman (US 2002/0194414).

Regarding Claim 9, Boyle teaches a memory device of a portable type

comprising: a terminal capable of being connected to an interface mounted on a host

machine and capable of data input/output from/to said host machine (I/O device 122,

connected to host machine 110 via connection 130), and a storage element for storing

data which include: at least one of image data and audio data (note how JPEG images

are stored in computer memory 220 in paragraph 0032), reproduction program data for

said host machine to reproduce at least one of said image data and audio data (see

reproduction program description in paragraph 0032, also note the storage element can

store the reproduction program and transfer it to the host, see paragraph 0010 and how

the imaging conduit that contains the reproduction program is installed on the PC

without the need for user interaction, i.e., when the storage element is first connected to

the host), and execution program data for said host machine to execute said

reproduction program using said reproduction program data (inherently present, since

the host machine executes the reproduction program as described in paragraph 0032)

and a writing program to write at least one of said image data and audio data from said

host machine to said storage element in response to a detection signal that said host

machine detects a connection of said terminal to said interface (the sync manager runs

after the device is connected, as described in paragraph 0010, also see the description

of the write program that uploads data from a personal computer 110 to the handheld

electronic device 124, paragraph 0036),

wherein at least one of the image data and audio data to be reproduced is

selected by a user ("the sync manager also provides the user the capability to change

the data on one device…and subsequently synchronize the changed data with data

located on the computing device", Paragraph 0024 in Boyle).

However, Boyle does not teach reproducing the data selected by a user

independently of the user's operation to change the selected data. Bateman teaches

letting a user select which images from a device to send to a separate device

independently of changing the images (Paragraph 0034 in Bateman, where the

"individual image selection operation" is described).

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to which the subject matter pertains to have implemented the

individual file selection of Bateman in the device of Boyle, because sometimes a user

may not wish to transfer all images from a host to a separate storage element.

Regarding Clam 10, Boyle teaches a portable memory device as described in

Claim 9, wherein the host machine can activate said execution program in response to

said detection signal to read and reproduce at least one of said image data and audio

data stored in said memory element (the sync manager runs after the device is

connected, as described in paragraph 0010, also see the description of uploading data

from a personal computer to the handheld electronic device, paragraph 0036), when

said host machine previously stores at least said reproduction program data and

execution program data (imaging conduit 310 of the sync manager, installed on the

host, paragraph 0010), and when said terminal is connected to said interface in the

state that said storage element stores at least one of said image data and audio data

(see Figure 6 and particularly steps 614, 618, and 620, where if the storage element

stores an image and is connected, the imaging conduit that contains the reproduction

program is run).

Regarding Claim 11, Boyle teaches a recording medium for storing a computer-

executable program, the program having program code comprising:

a detecting step of detecting detection signal indicating that a terminal of a

portable memory device is connected to said interface (see how the sync manager runs

after the device is connected, as well as an additional description in paragraph 0010

how the device runs without any need for user interaction); and

an executing step of executing a program in a reproduction program data for

reproducing at least one of image data and audio data stored in said memory device, in

response to said detection signal (see description of how the imaging conduit

reproduces the image data in paragraph 0032, also note that the host executes this

program, and thus an executing step is inherently present); and

a writing step to write at least one of said image data and audio data from a host

machine to said storage element (see description of writing the data from a personal

computer to the handheld electronic device, paragraph 0036),

wherein at least one of the image data and audio data to be reproduced is

selected by a user ("the sync manager also provides the user the capability to change

the data on one device…and subsequently synchronize the changed data with data

located on the computing device", Paragraph 0024 in Boyle).

However, Boyle does not teach reproducing the data selected by a user

independently of the user's operation to change the selected data. Bateman teaches

letting a user select which images from a device to send to a separate device

independently of changing the images (Paragraph 0034 in Bateman, where the

"individual image selection operation" is described).

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to which the subject matter pertains to have implemented the

individual file selection of Bateman in the device of Boyle, because sometimes a user

may not wish to transfer all images from a host to a separate storage element.

Regarding Claim 13, Boyle teaches a data processing system comprising:

a host machine having an interface capable of data input/output (computing

device 110), and a portable memory device comprising a terminal capable of being

connected to said interface (paragraph 0020), and a storage element for storing at least

one of image data and audio data (paragraph 0019), reproduction program data for said

host machine to reproduce at least one of said image data and audio data (see

reproduction program description in paragraph 0032, also note the storage element can

store the reproduction program and transfer it to the host, see paragraph 0010 and how

the imaging conduit that contains the reproduction program is installed on the PC

without the need for user interaction, i.e., when the storage element is first connected to

the host), execution program data for said host machine to execute a program in said

reproduction program data in response to a detection signal that said host machine

detects a connection of said terminal to said interface (see how the sync manager runs

after the device is connected, as well as an additional description in paragraph 0010

how the device runs 'without any need for user interaction), and a writing program to

write at least one of said image data and audio data from said host machine to said

storage element (see description of writing data from a personal computer to the

handheld electronic device, paragraph 0036),

   wherein at least one of the image data and audio data to be reproduced is

selected by a user ("the sync manager also provides the user the capability to change

the data on one device…and subsequently synchronize the changed data with data

located on the computing device", Paragraph 0024 in Boyle).

   However, Boyle does not teach reproducing the data selected by a user

independently of the user's operation to change the selected data. Bateman teaches

letting a user select which images from a device to send to a separate device

independently of changing the images (Paragraph 0034 in Bateman, where the

"individual image selection operation" is described).

   It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to which the subject matter pertains to have implemented the

individual file selection of Bateman in the device of Boyle, because sometimes a user

may not wish to transfer all images from a host to a separate storage element.

   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle

and Bateman in view of AppleCare Document: 122014.

   Regarding Claim 12, Boyle teaches all limitations of Claim 11 as described

above, wherein the program has code comprising

an outputting step of outputting at least one of said image data and audio data to said portable memory device (see description of outputting data from a personal computer to the handheld electronic device, paragraph 0036 in Boyle).

However, while Boyle mentions that images and 'other such data' (paragraph 0008) may be transferred across to the portable media device (also see paragraph 0036 where image data is downloaded to the portable device from a host device), he does not give an example of what this 'other data' may be. Apple's iPod, however, enables users to download software from Apple that is transferred from a host machine to the iPod portable memory device automatically once it is connected to the host machine (see first paragraph of AppleCare Document: 122014). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to add a controlling step of controlling to output said image reproduction and execution data onto the host computer and to transfer this program to the handheld device during the outputting step just as the iPod Updater has a controlling step of controlling to output audio reproduction and execution data. The motivation for this is that it keeps software programs flexible, and any minor bug in a program on a handheld device would be able to fixed by uploading to the handheld device a new version of software from the host (see AppleCare Document: 122014 for a list of bug fixes in the iPod software, for example).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle and Bateman in view of Kahn (US 2004/0004737).

Regarding Claim 14, Boyle teaches all limitations of Claim 13 as addressed above. Boyle clearly has a network (218 in Boyle) in his system, but does not explain what data could be transferred over the network. Kahn teaches a network over which images are shared, including an external apparatus (image server 331-333 in Kahn). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains that Kahn's network could be the network in Boyle. In this combination, when a device (such as handheld device 110) is connected to a host machine (such as 120 in Boyle) a program (such as the program specified in Kahn that begins at 522 in Figure 5, also see paragraph 0082) is run that uploads images to the external apparatus. The motivation for this comes from Kahn, who states that his network provides the benefits of automatic organization and easy sharing among friends (paragraph 0089 in Kahn).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle and Bateman in view of Sesek (US 2003/0076365).

Regarding Claim 15, Boyle teaches all limitations of Claim 9 as addressed above. Boyle teaches a memory device of a portable type that can store images as well as programs for exchanging these images, but does not teach displaying these images as icons or as a reduced image of a file. However, Sesek teaches a technique that displays reduced images, or "thumbnails" of each image that can be displayed by a host machine (see paragraphs 0008-0011 in Sesek). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject

matter pertains to integrate this display system into the writing program that writes

selected files to a portable memory device (such as that described in paragraph 0036 of

Boyle). Motivation for this comes from Sesek, who states that thumbnails 'are useful for

indicating the contents of a page or image' (paragraph 0007 in Sesek) and also that

they allow the user 'to easily select pages or images for viewing' (paragraph 0006 in

Sesek). Thus, by integrating Sesek's technique into the write program, additional

benefits are obtained.

ARGUMENTS CONCERNING PRIOR ART REJECTIONS

Rejections - USC 102/103

Applicant's arguments with respect to Claims 9, 11, and 13 have been fully

considered but do not appear to be supported in the specification or drawings as

described in the new matter rejections above. However, new grounds of rejection have

been made in view of a newly found prior art reference.

CLOSING COMMENTS

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the

application as recommended by **M.P.E.P. ' 707.07(i)**:

CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, claims 9-15 have received a second action on the

merits and are subject of a second action final.

DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to M. Anthony Giardino whose telephone number is (571)

270-3565 and can normally be reached on Monday - Thursday 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mr. Sanjiv Shah can be reached on (571) 272 - 4098. The fax phone

number for the organization where this application or proceeding is assigned is (571)

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

M.A. Giardino   /Stephen Elmore/
                                                       Primary Examiner, Art Unit 2185
/M.G./

Patent Examiner
Art Unit 2185

March 2, 2009